

Notice of Allowability

Application No.

09/982,094

Examiner

William D. Thomson

Applicant(s)

DEBLING, ANTHONY

Art Unit

2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 1/25/05.
2. ☒ The allowed claim(s) is/are 1-15.
3. ☒ The drawings filed on 15 January 2002 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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Art. 2123
TC 2102

DETAILED ACTION AND ALLOWANCE

1. Claims 1-10 were originally allowed over the prior of record. New claims have been presented in the instant RCE, in which amendments added claims 11-15.
2. Claims 1-15 have been examined and allowed over the prior art of record.
3. Formal drawings filed on January 15, 2002 have been accepted by the examiner.
4. Priority document has been received and priority has been established as October 18, 2000, based upon United Kingdom 0025591.9.

REASONS FOR ALLOWANCE

5. The following is an examiner's statement of reasons for allowance:

The prior art does not expressly teach or render obvious the invention as recited in independent claims 1, 2, 6, 7, 11, and 12.

6. The use of a universal serial bus (USB) to interconnect emulation systems was uncovered in US 2002/0059541 A1 (Swoboda) at [0066], however, the use of an RPC (remote procedure call) and addressing (claims 1 and 2) schema or RPC and socket schema (claims 6 and 7) with the USB, in the context of the claims, was not uncovered in the prior art teachings. A real time communications protocol, which is distinct from RPC was disclosed. Further, the prior art does not teach to using RPCs, sockets, and USB to provide interconnectivity and communications in the emulation environment as taught and claimed in the instant invention. Newly presented claims 11 and 12 follow in suite with the

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originally allowed claimed and retain the same allowable subject matter. The limitations directed to the specific environment of components including digital processing circuitry and on an on-chip emulator and connectivity for initiating command and control as recited in preambles of claims 11 and 12 are accorded patentable weight as they recite and provide limitations are required for completeness of the claims. The courts have held that "[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). Further, "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) Therefore, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963)

Though it is known to use remote procedure calls to communicate over networks, as it known to use sockets, the combined use of the RPC with the universal serial bus inclusive of the socket and addressing within the claimed

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invention's specific environment of on-chip emulation was not uncovered. Moreover, as the courts have held: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsisimilis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Nor was a reference uncovered that would have provided a basis of evidence for asserting a motivation that one of ordinary skill level in the art at the time the invention was made, knowing of emulation systems in this specific environment, would have integrated or modified the use of an RPC and addressing (Claims 1 and 2) or sockets (claims 6 and 7) with USB to result in an on-chip emulator communication system as recited in the context of the independent claims. This follows for newly presented claims 11 and 12.

Dependent claims are allowed as they depend upon allowable independent claims.

7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should

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preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

CONTACT INFORMATION

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William D. Thomson whose telephone number is 571-272-3718. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on 571-272-3716.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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